PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number 050704/306277
(filed with the Notice of Appeal)	

Application Number: 10/820,213	Filed: April 7, 2004

First Named Inventor: Richard Lunak

Art Unit: 2876	Examiner: ST. CYR, DANIEL

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

Respectfully submitted,

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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that this paper is being facsimile transmitted to the Patent and Trademark Office at Fax No. (571) 273-8300 on the date shown below.

LaRieko Welch   08-11-08
                       Date

Attachment
Reasons for Requesting Pre-Appeal Brief Request for Review

Applicants are requesting a Pre-Appeal Brief Request for Review on the basis that the Examiner has failed to show that the cited art teaches or suggests each and every element as set forth in the claims.

I. Introduction

Claims 1-4 are pending in the application. Claims 1-4 stand rejected under a final Office Action dated May 8, 2008. Specifically, the final Office Action rejects Claims 1 and 3-4 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,797,515 to Liff et al. ("the Liff reference"), and it rejects Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over the Liff reference in view of U.S. Patent No. 6,112,502 to Frederick et al. ("the Frederick reference").

Of the pending claims, Claim 1 is the sole independent claim and is reproduced below:

1.   A system, comprising:
       a plurality of open shelves containing bins for carrying items, said items having indicia associated therewith;
       a handheld device programmed to:
            read the indicia associated with an item for which a restock is desired;
            receive order quantity information associated with the read indicia for a decentralized storage location; and
            transfer the information associated with the read indicia and the order quantity information to enable a restocking package to be prepared;
       a workstation configured to receive a current quantity of said item stored in a centralized storage location; and
       a computing device configured to receive the transferred information and queue a restocking package to be processed for the decentralized storage location in response to the transferred information.

II. Rejections of the Claims

Applicants submit that the rejections of Claims 1-4 should be reversed because (A) the final Office Action is improper because it fails to assert that the cited references teach or suggest each and every element of the current claims, and (B) notwithstanding, the cited references fail to teach or suggest each and every element of the current claims.

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A. The rejections under 35 U.S.C. §102(b) and 35 U.S.C. §103(a) are improper

Applicants respectfully submit that the current rejection of independent Claim 1 is improper since, in order to anticipate a claim, the reference must teach every element of the claim. However, the final Office Action fails to even assert that the Liff reference teaches each and every element of independent Claim 1. As stated in MPEP 2131, citing the patent laws, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). However, the final Office Action refers to elements of Claim 1 that had been previously amended out of the claim language in the Preliminary Amendment filed on October 31, 2007, and, moreover, does not address the current language of independent Claim 1. For example, pages 2-3 of the final Office Action refer to "a computing device configured to receive the transferred information and compare the received quantity information to a par level for the item, so that the restocking package can be prepared when the quantity information is less than the par level." As of Preliminary Amendment of October 31, 2007, this portion of Claim 1 was amended to state "a computing device configured to receive the transferred information and queue a restocking package to be processed for the decentralized storage location in response to the transferred information." See Claim 1. The final Office Action fails to assert that the Liff reference teaches or suggests these claim elements. In fact, the final Office Action appears to repeat, verbatim, the rejections issued in the Final Rejection of November 27, 2006.

Accordingly, in the present case, given that the final Office Action fails to assert that the Liff reference discloses the above recited features and that no rationale or evidence showing inherency of these features has been set forth in the Office Action, the rejection of independent Claim 1 based on anticipation in view of the Liff reference is improper. Since the remaining claims depend from independent Claim 1, Applicants further submit that the rejections of Claims 2-4 are also improper.

B. Claims 1-4 are patentable over the cited references

Notwithstanding the impropriety of the current rejections, Applicants further submit that the cited references fail to teach or suggest the features of independent Claim 1. In this regard, for example, independent claim 1 recites, *inter alia*, "a plurality of open shelves containing bins for carrying items, said items having indicia associated therewith; a handheld device programmed to: read the indicia associated with an item for which a restock is desired, receive order quantity information

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associated with the read indicia for a decentralized storage location, and transfer the information associated with the read indicia and the order quantity information to enable a restocking package to be prepared; a workstation configured to receive a current quantity of said item stored in a centralized storage location; and a computing device configured to receive the transferred information and queue a restocking package to be processed for the decentralized storage location in response to the transferred information." (Emphasis added). Applicants submit that neither the Liff reference nor the Frederick reference, alone or in combination, teaches or suggests the elements of independent Claim 1, as previously amended.

The Liff reference discloses (referring to **Fig. 1**, for example) a system for dispensing pharmaceuticals that includes a cabinet **20**, a host computer **46**, and bar code reader **40**, which may comprise a hand-held bar code reader unit **41**. *See* Liff reference, col. 5, lines 8-18; col. 6, lines 45-46. The cabinet **20** includes columns **34** that may be loaded with pharmaceutical packages **32**. Before a column **34** is loaded with a package **32**, a column bar code label **76** is compared with a bar code label **76** on the package **32**. This comparison may take place visually as the reference does not explicitly teach or suggest scanning either the package bar code label or the column bar code label to perform the comparison. *See* Liff reference, col. 6, lines 45-67. During loading, the packages **32** are loaded up to a certain height designated by a column label **75**. The Liff reference then teaches scanning the package bar code label as each package is dispensed. *See* Liff reference, col. 6, lines 51-54. However, the Liff reference does not teach or suggest a handheld device programmed to receive order quantity information associated with read indicia for a decentralized storage location; a workstation configured to receive a current quantity of said item stored in a centralized storage location; or a computing device configured to queue a restocking package to be processed for the decentralized storage location in response to the transferred information, as recited in independent Claim 1.

With respect to a handheld device, the final Office Action refers to col. 7 of the Liff reference generally. However col. 7 of the Liff reference does not teach or suggest a handheld device configured to receive order quantity information associated with read indicia for a decentralized storage location. With respect to a workstation configured to receive a current quantity of an item stored in a centralized storage location and a computing device configured to receive the transferred information and queue a restocking package to be processed for the decentralized storage location in response to the transferred information, indeed the final Office Action does not suggest that Liff discloses these elements.

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The Frederick reference, which is cited in the final Office Action with regard to the rejection of Claim 2, discloses a method for monitoring, dispensing, and restocking medical items from a plurality of storage locations. Each storage location of the Frederick reference is marked with a desired level or quantity for the item contained therein. Each storage location is further marked with one or more scannable indicia (e.g., bar code labels) corresponding to a "quantity condition." For example, one scannable indicium may correspond to a "below par level" condition, while another indicium may correspond to an "out of stock" condition. A user of the system determines whether an item requires restocking, such as by determining if the current quantity of the item is below the indicated par level or if the item is out of stock. The user then scans the appropriate indicium, corresponding to the determined quantity condition, using a handheld device. This causes the transmission of a message indicating that the particular storage location requires restocking. A data store may also include data representative of the number of units remaining in each storage location. However, the Frederick reference does not teach or suggest a handheld device programmed to receive order quantity information associated with the read indicia for a decentralized storage location; a workstation configured to receive a current quantity of said item stored in a centralized storage location; or a computing device configured to queue a restocking package to be processed for the decentralized storage location in response to the transferred information, as recited in independent Claim 1 and thus incorporated into dependent Claim 2. Indeed, the final Office Action does not suggest that the Frederick reference discloses these elements.

Because neither the Liff reference nor the Frederick reference teaches or suggests the claim elements of independent Claim 1, Applicants submit that the rejections under 35 U.S.C. §102(b) of independent Claim 1, as well as dependent Claims 3-4, should be reversed. Additionally, because Claim 2 depends from Claim 1, Applicants submit that the rejection of dependent Claim 2 under 35 U.S.C. §103(a) should also be reversed.

IV. Conclusion

In the present situation, not only do the Liff and Frederick references, alone or in combination, fail to teach or suggest the claimed features regarding a handheld device programmed to receive order quantity information associated with the read indicia for a decentralized storage location, a workstation configured to receive a current quantity of said item stored in a centralized storage location, and a computing device configured to receive the transferred information and queue a restocking package to

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